

04-23-02

DAC #3

Express Mail # EV093668673US



Attorney Pocket # 2132-52PCON

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Harri VATANEN, et al

Serial No.: 09/931,338

Filed: August 16, 2001

For: Method For Transmission of Secure Messages in
a Telecommunications Network

Examiner: Not Yet Assigned
Group Art: 2681

RECEIVED

APR 24 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Attn: Box Petitions
Washington, DC 20231

PETITION UNDER 35 U.S.C. §116 AND 37 C.F.R. §1.47(a)

SIR:

This Petition is submitted pursuant to 35 U.S.C §116 and 37 C.F.R. §1.47(a) to request that the U.S. Patent and Trademark Office ("PTO") accept the filing of the above-identified U.S. Patent Application by joint co-inventors Jukka Liukkonen and Matti Hiltunen, on behalf of themselves *and* on behalf of their co-inventor, Harri Vatanen, because the latter co-inventor Harri Vatanen has refused to execute the subject U.S. Patent Application despite diligent efforts to have him sign a Declaration in support of the application.

The undersigned, and other attorneys in the law firm of the undersigned, are the attorneys for Sonera Oyj (formerly known as Sonera Oy¹), a corporation of Finland, and of its wholly-owned subsidiary Sonera Smarttrust Oy, also a corporation of Finland (hereinafter jointly,

¹ The change of name of the Finnish company "Sonera Oy" to "Sonera Oyj" was an obligatory change when the company was listed on the Finnish Stock Exchange. An English-language translation of

unless otherwise indicated, referred to as "Sonera"). The undersigned is empowered and has the authority to act on behalf of Sonera, which is the proper, legitimate and lawful owner of the invention of the subject U.S. application.

In brief, and as explained more fully below, (1) Harri Vatanen, Jukka Liukkonen and Matti Hiltunen are the named and actual joint co-inventors of the subject U.S. patent application, (2) Mr. Vatanen has refused to sign a Declaration in support of the U.S. application, despite repeated oral and written requests that he do so by employees of Sonera; (2) co-inventors Jukka Liukkonen and Matti Hiltunen *have* each executed an identical Declaration for this application, a Declaration that also contains a blank signature block of the non-signing inventor Harri Vatanen and may therefore properly be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor (see MPEP §409.03(a)); (3) Sonera is the owner of all rights in and to the subject US application because the three named co-inventors, *including* the non-signing inventor Harri Vatanen, have already *expressly* assigned in writing, for all countries, the invention which is the subject of this application to Sonera Oy (now Sonera Oyj) and have also *expressly* agreed in writing, in the same document, (i) to execute any necessary documents required in connection with all domestic and foreign patent applications, i.e. including the U.S. application that is the subject of this Petition, and (ii) that Assignee Sonera Oy may if necessary execute such documents on Mr. Vatanen's (and his other co-inventors') behalf; and (4) Sonera is also the owner of all rights in and to the subject US application as a matter of law because, as employees of Sonera, each of the three named co-inventors (including Mr. Vatanen) is required, under Finnish statutory law, to assign the invention which is the subject of this U.S. application to their employer Sonera.

the extract for Sonera Oyj from the Finnish Register of Companies is attached as Exhibit 1 hereto.

On August 16, 2001, the undersigned filed (by U.S. Postal Service Express Mail) the papers necessary to obtain a filing date for a new U.S. patent application under 35 U.S.C. §1.53(b), based on the priority of Finnish patent application No. 990,323, filed February 16, 1999, and International (PCT) Patent Application No. PCT/FI00/00116, which had been filed on February 16, 2000 and in which the United States was properly designated. That Section 1.53(b) filing request in the PTO was accompanied, *inter alia*, by an unexecuted Declaration of the three joint co-inventors, i.e. Harri Vatanen, Jukka Liukkonen and Matti Hiltunen.

The Finnish priority application was filed by Sonera Oy (now Sonera Oyj) as applicant, and the International (PCT) priority application was filed by Sonera Smarttrust Oy as applicant (for all countries except the United States, with respect to which Mr. Vatanen, Mr. Liukkonen and Mr. Hiltunen were named as joint applicants). Both the Finnish and International (PCT) priority applications are directed to the same invention as that disclosed and claimed in the subject U.S. application. Messrs. Vatanen, Liukkonen and Hiltunen, as joint inventors, executed an Assignment of the International (PCT) priority application to Sonera Oy (a copy of that Assignment document is attached to the Declaration of European Patent Attorney Markku Simmelvuo, Exhibit 2 hereto). That Assignment of the International (PCT) priority application included the following statement:

"The assignment of the rights includes a transfer of the patent rights in all countries, as well as the right to use a convention priority of the Finnish patent application in all countries.

The assignee alone hereinafter has the entire disposal of the invention and possesses the entire ownership to any domestic and foreign patents granted thereafter. The assignor/s undertake/s to sign all documents necessary for taking out a patent and, furthermore, all such documents which may be required to assert rights transferred hereby.

If the assignor/s is/are prevented by any obstacles from signing said documents in person, this document of assignment shall be valid as a Power of Attorney for the assignee or for whom the rights have been transferred to sign these documents on behalf of the assignor/s or in the event of the death of the latter, the estate thereof."

(See the Assignment attached to the Exhibit 2 Declaration of Markku Simmelvuo.) Messrs. Vatanen, Liukkonen and Hiltunen, as joint inventors/applicants for the designated United States in the International (PCT) priority application, also executed a Power of Attorney with respect to the International (PCT) priority application to the Finnish law firm Papula Oy (a copy of that Power of Attorney is attached to the Declaration of Markku Simmelvuo, Exhibit 2 hereto).

As noted above, the U.S. application which is the subject of this Petition was filed on August 16, 2001 and was accompanied on filing by an unexecuted Declaration of the joint inventors, Harri Vatanen, Jukka Liukkonen and Matti Hiltunen. The unexecuted Declaration identified the undersigned and other members and employees of undersigned's law firm (Cohen, Pontani, Lieberman & Pavane) as the record attorneys for the application, and identified undersigned's law firm as the mailing address for all correspondence in connection with the application.

On August 23, 2001, the undersigned sent a letter to European patent attorney Markku Simmelvuo of the Finnish law firm Papula Oy, confirming the filing of the application in the PTO by U.S. Postal Service Express Mail on August 16, 2001. (We correspond with Sonera through the Finnish law firm Papula Oy, from whom we also receive the instructions of Sonera.) Our letter of August 23, 2001 enclosed a copy of the application as filed in the PTO on August 16, 2001, and stated that a further Declaration and Power of Attorney for execution by the three co-inventors, Mssrs. Vatanen, Liukkonen and Hiltunen, would be forwarded to Mr. Simmelvuo upon receipt from the PTO of the return receipt postcard reporting the Serial Number that had been

assigned to the application. A copy of that August 23, 2001 letter (but omitting the copy of the application as filed and the other enclosures that accompanied that letter) is attached as Exhibit 3 hereto.

On September 8, 2001 - having on August 27, 2001 received back from the PTO the return receipt postcard that had been filed with the application papers on August 16, 2001 and which now carried the Serial Number (09/931,338) that had been assigned to the application - the undersigned sent a further letter to European patent attorney Markku Simmelvu of the Finnish law firm Papula Oy, informing of the Serial Number and filing date that had been assigned to the U.S. application and forwarding with that letter a Declaration and Power of Attorney document, in which the application was identified by its Serial Number and filing date, for execution by the three co-inventors Harri Vatanen, Jukka Liukkonen and Matti Hiltunen. (Since a copy of the application as filed had already been sent to Mr. Simmelvu with our prior letter of August 23, 2001 (Exhibit 3), an additional copy of the application as filed was not forwarded with our letter of September 8.)

On September 21, 2001, a paper entitled "Notice to File Missing Parts of Nonprovisional Application Filed Under 37 CFR 1.53(b)", noting the lack of an executed Oath or Declaration of the inventors in the papers filed in the PTO with the subject U.S. patent application, was mailed to the undersigned by the PTO. That Notice was received by undersigned's law office on September 25, 2001. A copy of that "Notice to File Missing Parts", as received by undersigned's law office on September 25, 2001, is attached as Exhibit 4 hereto.

By fax letter of October 4, 2001, the undersigned informed European patent attorney Markku Simmelvu of our receipt of the "Notice to File Missing Parts", and provided Mr. Simmelvu with an accompanying copy of that Notice. (A copy of the October 4, 2001 fax letter - on which additional notations indicating the dates on which the letter was resent by fax to Mr.

Simmelvuo as a reminder of the extended deadline(s) for filing of the executed Declaration - is attached as Exhibit 5 hereto.)

Sonera has made repeated unsuccessful attempts to obtain the signature of the non-signing joint inventor, Harri Vatanen, on a Declaration relating to the subject U.S. patent application. As reported by Paivi Soderman, Patent Manager of Sonera Smarttrust Oy, in his attached Declaration (Exhibit 6 hereto), Sonera has forwarded a "Declaration and Power of Attorney" to Mr. Vatanen and made repeated attempts, both in writing and orally, to obtain Mr. Vatanen's signature on that Declaration. Despite Sonera's repeated oral and written efforts to obtain the signature of Mr. Vatanen on the required Declaration and Power of Attorney, and the repeated promises by Mr. Vatanen to sign the Declaration, the inventor has failed and refused to sign the document and thereby necessitated the filing of this Petition.. (See the Declaration of Paivi Soderman, Exhibit 6 hereto.)

Mr. Vatanen's joint co-inventors Jukka Liukkonen and Matti Hiltunen, on the other hand, *have* each signed a Declaration and Power of Attorney for the subject application; identical copies of that Declaration, one signed by Mr. Liukkonen and the other signed by Mr. Hiltunen, are attached as respective Exhibits 7 and 8 hereto. The identical Declarations signed by Mr. Liukkonen and Mr. Hiltunen each also include a signature block of the non-signing joint inventor Harri Vatanen which is, however, blank (i.e. unsigned) by virtue of Mr. Vatanen's refusal to execute a Declaration in support of the subject U.S. application.

Non-signing joint inventor Harri Vatanen's last-known, and on information and belief his current, address is 2 Rushmore Place, Englefield Green, TW20 0NN Surrey, United Kingdom. All communications with Mr. Vatanen seeking his signature on the Declaration for the

subject U.S. application have been directed to that address and/or faxed to Mr. Vatanen's last-known (and, on information and belief, his then and presumably now current) fax number.

Mr. Vatanen is under a duty, as a matter of law, to assign the subject U.S. patent application to Sonera as a direct consequence of his employment by Sonera. The attached Exhibit 2 Declaration of European Patent Attorney Markku Simmelvuo, of the Finnish patent firm Papula Oy, states that under Finnish statutory law an employee's inventions are owned by the employee, in this case Sonera. The Exhibit 2 Simmelvuo Declaration also states that inventor Harri Vatanen was an employee of Sonera at the time that the invention of the priority Finnish patent application, and correspondingly of the subject U.S. application, was made.

In addition, as also noted above, Mr. Vatanen (as well as each of his co-inventors) has already expressly assigned in writing the underlying priority International (PCT) patent application to Sonera (see the attachment to Exhibit 2), and in that assignment document (i) assigned "the patent rights [to the invention] in all countries", (ii) acknowledged that the assignee (Sonera) "possess[es] the entire ownership to any domestic and foreign patents" thereafter filed and granted on the invention, (iii) agreed "to sign all documents necessary" to enable the assignee Sonera to obtain domestic and foreign patents on the invention, and (iv) granted to the assignee Sonera a "Power of Attorney" permitting Sonera to execute documents on behalf of Mr. Vatanen, in connection with the obtaining of domestic and foreign patents on the invention, in the event that Mr. Vatanen is unavailable or unable to do so. Accordingly, Sonera is clearly already the express owner of the subject U.S. application (and the underlying invention thereof) by virtue of Mr. Vatanen's (and each of his co-inventors') execution of the Assignment document relating to the International (PCT) priority application.

As the clear owner - both as a matter of law *and* by the express written transfer of rights from Mr. Vatanen and each of his co-inventors - of the subject U.S. application and the invention which is the subject matter thereof, it accordingly was and remains today proper for Sonera to take the responsibility and to carry out the actions appropriate for obtaining, or at least diligently attempting to obtain, co-inventor Harri Vatanen's signature on a Declaration in support of the U.S. patent application, as it did.

In view of (1) joint inventor Harri Vatanen's failure and refusal to sign a Declaration in support of the subject U.S. patent application, (2) the execution by Mr. Vatanen's two co-inventors Jukka Liukkonen and Matti Hiltunen, each on behalf of himself *and* on behalf of the non-signing inventor Mr. Vatanen, of a proper Declaration (attached as Exhibits 7 and 8 hereto) in support of the U.S. application, and (3) the demonstrated diligent efforts by Sonera - the proper, legitimate and lawful owner of the invention of the U.S. application - to obtain inventor Harri Vatanen's signature on a supporting Declaration, it is respectfully requested that the U.S. Patent and Trademark Office grant this Petition and accept the filing of the subject U.S. patent application by inventors Jukka Liukkonen and Matti Hiltunen on behalf of themselves *and* on behalf of their co-inventor, Harri Vatanen who has refused to sign such supporting Declaration.

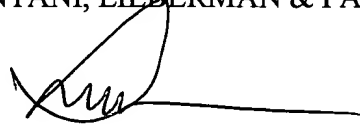
The undersigned hereby declares that all statements made herein of his own knowledge are true, and that all statements made on information and belief are believed to be true; and, further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

A check in the amount of \$1,960.00 in payment of the government fee for a five-month extension of time, a check in the amount of \$130.00 in payment of the government fee for the filing of "missing parts" in response to the September 21, 2001 Notice, and a check in the amount of \$130.00 in payment of the government fee for the filing of this Petition, are enclosed herewith.

Any additional fees or charges required at this time in connection with the subject patent application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE



By _____

Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: April 22, 2002

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OFFICE OF PETITIONS

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND



EXTRACT FROM THE TRADE REGISTER

Trade name: Sonera Oyj

Business Identity Code: 1475607-9
Trade Register Number: 740.009
Company Registered: 30.06.1998
Company Form: public limited company
Domicile: Helsinki

Company's Contact Information:

Mailing Address: PL 106, 00051 Sonera

Visiting Address: Teollisuuskatu 15, 00510 Helsinki

Register entries:

TRADE NAME (registered 01.10.1999)
Sonera Oyj.

PARALLEL TRADE NAME (registered 01.10.1999)
(English) Sonera Corporation.

DOMICILE (registered 30.06.1998)
Helsinki.

BOARD OF DIRECTORS (registered 30.05.2001)

Chairman:

Tapio Jussi Anselmi Hintikka

Ordinary members:

Jorma Tapio Laakkonen

Eva Helena Maria Liljebloom

Jussi Eerikki Lämsä

Roger Ensio Talermo

Esa Erkki Tihlilä

Tapio Johannes Vaahtokivi

Tom Wilhelm von Weymarn

Deputy members:

Kari Ilmari Vilkman

OTHER MANAGEMENT (registered 11.10.2001)

Managing Director:

Harri Eerik Koponen

Substitute for the Managing Director:

Aimo Eloholma

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OFFICE OF PETITIONS

LEGAL REPRESENTATION (registered 03.07.1998)

Under the Companies Act, the Company's name is signed by the Board of Directors.

SIGNING ON BEHALF OF THE COMPANY (registered 21.09.1998)

According to the articles of association, the company's name is signed by the managing director on his own, and by two members of the board of directors together.

AUTHORIZATION TO SIGN FOR THE COMPANY (registered 05.09.2001)

Aimo Eloholma

Kim Juhani Ignatius

Jari Vesa Jaakkola

Maire Annikki Laitinen

Kirsti Helinä Lehtovaara-Kolu

Pekka Heikki Juhani Reijonen

Esko Juhani Rytönen

Leif Niklas Mikael Sonkin

Juha Pekka Varelius

Anni Kaarina Vepsäläinen

Persons authorized to sign for the company sign two together or each of them separately together with a member of the board.

PROCURATION RIGHTS (registered 12.11.2001)

Jari Juhani Kinnunen

Jukka Erkki Kämäri

Jukka Tapani Leinonen

Sirkka Anneli Marjakangas

Erkki Antero Oksanen

Tapani Mikael Pökkä

Lauri Pekka Takala

Jorma Leo Tukia

Tiia Silja Kristiina Tuovinen

The holders of procuration sign the company name two together or each of them separately together with a member of the board or with a person authorized to sign the company name.

TRADE NAME HISTORY:

01.10.1999 - Sonera Oyj

03.07.1998 - 30.09.1998 Sonera-yhtymä Oyj

30.06.1998 - 02.07.1998 Telecom Finland Yhtymä Oy

Helsinki, 17 January 2002

For a true copy of the extract:

Tuija Surojegin
Administrative Officer

Fee 91,50 euro

STATEMENT

Sonera Smarttrust Oy owns the rights to the invention "METHOD FOR TRANSMISSION OF SECURE MESSAGES IN A TELECOMMUNICATION NETWORK", a patent application concerning which is pending in the USA under the application number 09/931338. A patent has been applied for the invention also in Finland under the application number FI 990323 and with an international patent application PCT/FI00/00116. These applications are also the priority applications of the above-mentioned U.S. application.

With the enclosed assignment the joint inventor, Harri Vatanen, has transferred his rights to said invention "METHOD FOR TRANSMISSION OF SECURE MESSAGES IN A TELECOMMUNICATION NETWORK " to Sonera Oy, which belongs to the same consolidated corporation as Sonera Smarttrust Oy, to which Sonera Oy has transferred the right. Sonera Oy owns Sonera Smarttrust in its entirety and in that regard they are one company. In the assignment it has been stated that the assignee gets a right to dispose the invention, and in addition, Vatanen has promised to sign all the necessary documents that are needed in order to confirm the assignment.

In addition, the inventor Vatanen has signed a power of attorney to the Finnish attorney of Sonera Smarttrust Oy Papula Rein Lahtela Oy (at present Papula Oy) for the international patent application PCT/FI00/00116 in order that one could also mention the USA in the international patent application. Enclosed is a copy of said power of attorney.

Enclosed please find an extract from the law about the employer's right to the inventions made by the employee with its translations into English. Section 4 of the law shows that if the invention was made when fulfilling the duties of the employee in employment, then the rights to the invention belong to the employer. This is very unambiguous,

ASSIGNMENT

SIIRTO

I/We hereby declare that I/we

Vakuutan/Vakuutamme, että mina/me

Harri Vatanen

Have assigned to

Olen/olemme siirtäneet yritykselle

Sonera Oy
P.O.Box 106, FIN-00051 Sonera
(Teollisuuskatu 15, 00510 Helsinki, Finland)

my/our right to invention, priority, patent
applications and patents, in all countries, on an
invention

oikeuteni/oikeutemme keksintöön, etuoikeu-
teen, patentihakemuksiin ja patenteihin
kaikissa maissa seuraavaan keksintöön:

titled by / nimitys: **MENETELMÄ TIEDON TURVAAMISEKSI**filed in Finland on / joka on pantu vireille Suomessa **16.2.1999**having the filing number / hakemusnumerolla **990323**

and/or Sonera's case number / ja/tai Soneran asianumerolla

The assignment of the rights includes a
transfer of the patent rights in all countries, as
well as the right to use a convention priority of
the Finnish patent application in all countries.

Oikeuksien siirto sisältää oikeuksien siirron
kaikissa maissa ja oikeuden käyttää etuoikeutta
suomalaisesta patentihakemuksesta kaikissa
maissa.

The assignee alone hereinafter has the entire
disposal of the invention and possesses the
entire ownership to any domestic and foreign
patents granted thereafter. The assignor/s
undertake/s to sign all documents necessary for
taking out a patent and, furthermore, all such
documents which may be required to assert
rights transferred hereby

Siirronsaajalla on tämän jälkeen keksintöön
määräämisoikeus ja hänellä on omistus-
oikeudet kaikkiin kotimaisiin ja ulkomaisiin
myönnettyihin patenteihin. Luovuttaja/luovut-
tajat lupaa/lupaavat allekirjoittaa kaikki tarpeel-
liset asiakirjat patentin luovuttamiseksi ja lisäksi
kaikki asiakirjat, jotka vaaditaan oikeuksien
siirron vahvistamiseksi.

If the assignor/s is/are prevented by any
obstacles from signing said documents in
person, this document of assignment shall be
valid as a Power of Attorney for the assignee
or for whom the rights have been transferred to
sign these documents on behalf of the
assignor/s or in the event of the death of the
latter, the estate thereof.

Jos luovuttaja/luovuttajat on/ovat estynyt/esty-
neet allekirjoittamasta asiakirjoja henkilökohtai-
sena, tämä siirtoasiakirja on pätevä asiamies-
valtakirjana siirronsaajalle tai sille, jolle
oikeudet on siirretty, näiden asiakirjojen
allekirjoittamiseksi luovuttajan/luovuttajien tai
jälkimmäisen/jälkimmäisten kuoleman tapauk-
sessa, sen/niiden kuolinpesän puolesta.

Place and date / Paikka ja aika

Helsinki
20.7.99Signature of the assignors /
Luovuttajan/jien allekirjoitusClarification of signature/s
Allekirjoituksen selvennys

Harri Vatanen

Address of the assignor/s
Luovuttajan/jien osoiteLepolanue 25 A 3
00660 Helsinki

Patentit, tavaramerkit ja mallit
 Patent, varumärken och mönster
 Patents, Trade Marks and Designs
 Patente, Warenzeichen und Muster

128695

SUOMI
 FINLAND

VALTAKIRJA
 Täten

FULLMAKT
 för

POWER OF ATTORNEY
 to

VOLLMACHT
 für

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 Patent and Trade Mark Attorneys
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 Telefax +358 9 3480 0630, 3480 0631

tai määräämässä valtuutetaan
 edustamaan minua/meitä

eller förordnar att representera
 mig/oss

or any one whom they may appoint
 to represent me/us

oder von ihnen ernanntem, mich/
 uns

kansainvälisessä patenttihakemuksessa

in international patent application

METHOD FOR THE PROVISION OF DATA SECURITY

etuoikeus/priority: 16.02.1999 - FI - 990323

ja kaikessa, mikä asiaa, hakemus-
 ta, tasta jakamalla erotettuja ja loh-
 kautuja hakemuksia ja hakemusten
 perusteella myönnettyjä suojaor-
 keuksia koskee, kantamaan ja vas-
 taamaan.

och i allt vad beträffar ärendet, an-
 sökningen, därur avdelade och ut-
 brutna ansökningar och på grund
 av sagda ansökningar beviljade
 skyddsrätter. föra talan och svara.

and in everything concerning the
 matter, application, applications
 therefrom branched off or divided
 as well as protective rights granted
 on said applications, to pursue
 claim and to reply.

zu vertreten und in allem, was die
 Sache, Anmeldung, davon abge-
 teilte oder ausgeschlossene Anmel-
 dungen sowie auf Grund derselben
 erteilte Schutzrechte betrifft, zu
 klagen und zu antworten.

Paikka, päiväys ja
 hakijan allekirjoitus

Ort, datum och
 sökandens underskrift

Place, date and
 signature of Applicant

Ort, Datum und
 Unterschrift des Anmelders

Harri Vatanen

Ei vahvistusta
 Ingen legalisering
 No legalization
 Keine Beglaubigung



Rekisteröidyt patenttiasiamiehet
 Registered Patent Attorneys
 European Patent Attorneys

PAPULA and NEVINPAT offices,
 specialists in industrial property
 rights in Finland and the former
 USSR countries.

1 §

In this law, a consolidated corporation is used to refer to a consolidated corporation in accordance with chapter 6 of section 1 of the Bookkeeping Act (1336/1997), as well as to a municipality and municipal federation and companies under its authority as referred to in subsection 2 of section 5 and section 6 of chapter 1 of the Bookkeeping Act .

4 §

If the invention is a result of activities carried out in order to fulfill the duties of an employee, or by utilizing the experience gained in a company or organization of the employer or in one belonging to the same consolidated corporation with it, the employer has the right, provided that the utilization of the invention is included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it, to obtain the right to the invention either wholly or partially. If the invention was produced by the employee as a result of a duty more specifically defined in the employment, the employer has the aforementioned right, although the utilization of the invention is not included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it.

If it is a question about an invention the utilization of which is included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it but which was produced in connection with an employment relationship other than prescribed by subsection 1, the employer is entitled to obtain the right of use of the invention.

If the employer wishes to obtain a right to an invention referred to in subsection 2 that is wider than the one prescribed in it, or a right to an invention that was produced without a connection to an employment relationship but the utilization of which, however, is included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it, the employer has the priority to obtain the right in question by agreeing on it with the employee.

3

Finnish Expatriate with Family

is applicable to this Contract

७:८

20-JUN-2000 03:47 FROM:

INTERNATIONAL ASSIGNMENT CONTRACT

The Employer and the Employee defined hereinafter have agreed on the following terms and conditions of employment regarding temporary work to be performed abroad:

1 TERMS AND CONDITIONS

1. Parties to the Assignment Contract


Employer, Home Country: Sonera Corporation, FINLAND
(Home Company)

Employee: Surname: Vatanen
First names: Harri
Date of birth: 111062-107L
(social security code)

Host Country: United Kingdom

This agreement is based on the primary employment with Sonera Corporation and the Employee.

2. Assignment duties

Task: *Managing Director*; *CEO*; Managing Director, SmartTrust Ltd., London 

Main duties are defined in a separate job description (enclosed).

The Employee undertakes to perform in the Host Country other duties falling within the scope of his skills and experience that may be required in accordance with the Employer's instructions.

Employee's superior
in the Home Company: Kaj-Erik Relander

3. Duration of the Assignment Contract

This Assignment Contract commences on 15.6.1999, or when the Employee actually departs for the Host Country.

The date of termination of this Contract will be 14.6.2002.

FOR: Harri Vatanen

4. Remuneration

The Employee is paid a net monthly salary from the actual date this Contract commences.

ing from the

The salaries are paid monthly on last day of each month.

Unless otherwise agreed in specific cases, compensation for overtime and other irregular working time is included in the Employee's monthly salary.

The Employee is entitled to sick pay in accordance with the practice applied by the Employer.

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t
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5. Working hours and public holidays

The Employee's basic working hours shall follow the current practice of the Employer.

The Employee agrees to adapt his working hours flexibly as may be necessary for the performance of his duties.

The practice of the Host Company and legislation of the Host Country shall be followed insofar as paid public holidays are concerned.

6. Annual leave

The Employee is entitled to annual leave in accordance with the practice of the Employer.

7. Other paid leave

In case of a serious illness or death of a child, spouse, parent, grandparent, sister or brother of the Employee or his spouse, the Employee is entitled to compassionate leave. The length and time at which such leave is taken must be agreed with the Superior in Finland.

In connection with moving to the Host Country and back to his Home Country, the Employee is entitled to one additional days' paid leave, if necessary.

FOR: Harri Vatanen

and based on this, the right to the invention belongs clearly to the employer of Vatanen. We enclose a copy of the work contract which shows that Vatanen was in an employment relationship with Sonera Oy at the time the invention, i.e. the Finnish application FI 990323, was made.

Helsinki, 9th April 2002

A handwritten signature in black ink, appearing to read 'Markku Simmelvuo', followed by a long horizontal flourish.

Markku Simmelvuo,
European patent attorney
PAPULA OY

Q

The Employee is covered by the Home Country social security, if possible, based on International Conventions and Home and Host Country legislation.

9. Taxation

10. The Employee's family

NADIC

date of birth

DP-SUM

by The

FOR: Hart Vardon

13. Moving costs

In addition to ordinary transportation of luggage within the limits stipulated in the travel tickets, the Employee and his accompanying family members' will be entitled to transportation of his personal belongings to the Host Country and back to the Home Country by surface freight up to the limit of

- 16 m³, if furnished apartment agreed
- 45 m³, if unfurnished apartment agreed

at the Host Company's expense.

14. Holiday trips

During this Assignment period, the Employee and his accompanying family members are entitled to ~~the~~ (X) holiday trip to the Home Country, at the Employer's expense. *Si x (6)*

Ilmainen

III REPATRIATION

a) After termination of this Assignment Contract, the Employee is guaranteed a position within the Telecom Finland in the Home Country substantially similar to the position held by him in the Home Company before commencement of this

FOR: Harri Vainonen

6

international assignment. It is understood that after termination of this assignment contract all allowances and benefits will be discontinued.

IV TERMINATION

In addition to the terms and conditions of termination stipulated in the primary employment contract of the Employee, this Contract may be terminated under the following terms and conditions:

- a) Due to unexpected and unforeseen reasons outside the powers of the parties to this contract, should such a reason obstruct the proper fulfilment of this Contract.
- b) Employee's negligence in performance during the international assignment or fundamental breach of contract by any of the contract parties.
- c) Should this assignment contract be terminated before the date stated in this contract due to unforeseen reasons in the business, the salary and cost allowances shall be paid on the basis of this contract till the end of the agreed period.

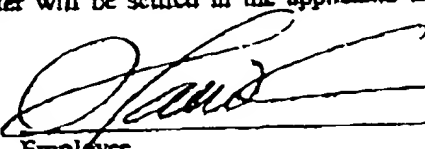
V REFERENCE TO LEGISLATION

Unless otherwise agreed in this Assignment Contract, the current legislation of the Home Country on employment contracts is applicable to this Contract, insofar as it does not contradict the mandatory legislation which may apply in the Host Country.

VI DISPUTES

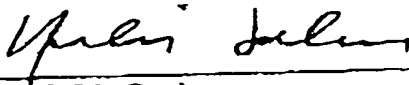
Any ambiguities in the terms and conditions of this Assignment Contract will be resolved in discussions between the Employer, the Employee and the Host Company. In case of dispute, the matter will be settled in the applicable Court of Law in the Home Country.

place and date



Employee

place and date



On behalf of the Employer

15.6.99 P.M.

On behalf of the Corporate HR

FOR: Harri Vatanen

COHEN, PONTANI, LIEBERMAN & PAVANE

COUNSELLORS AT LAW

PATENTS, TRADEMARKS & COPYRIGHTS

551 FIFTH AVENUE

NEW YORK, NEW YORK 10176

TEL: (212) 687-2770

FAX: (212) 972-5487

MYRON COHEN
THOMAS C. PONTANI, PH.D.
LANCE J. LIEBERMAN
MARTIN B. PAVANE
MICHAEL C. STUART
WILLIAM A. ALPER
KLAUS P. STOFFEL
EDWARD M. WEISZ



August 23, 2001

YUNLING REN, PH.D.
JULIA S. KIM
MINDY H. CHETTIH
VINCENT M. FAZZARI
CATRIONA M. COLLINS
ALFRED W. FROEBRICH
ALFRED H. HEMINGWAY, JR.
KENT H. CHENG, PH.D.
ROGER S. THOMPSON
JEREMY A. KAUFMAN
GEORGE J. BRANDT, JR.
TEDDOR J. HOLMBERG
F. BRICE FALLER

Markku Simmelvuori, Esq.
Papula Oy
Box 981
SF-00101 Helsinki
Finland

Re: New U.S. Patent Application
Method for Transmission of Secure Messages in a Telecommunications
System
Your Ref.: 14916S
Our File No. 2132-52PCON

RECEIVED

APR 24 2002

OFFICE OF PETITIONS

Dear Markku:

Pursuant to your letter of 15 August 2001, we filed the above-identified patent application in the United States Patent and Trademark Office 16 August 2001 in order to preserve the convention priority. A copy of the application as filed is enclosed for your records.

Since we filed the application in unexecuted condition, upon receipt of the Serial Number that has been assigned to this application, we will forward an appropriate Declaration and Power of Attorney and Assignment documents for execution by the inventors, **Harri Vatanen, Jukka Liukkonen and Matti Hiltunen.**

Also enclosed is our invoice for services rendered in connection herewith.

In view of the disclosure rules of the U.S. Patent and Trademark Office, please provide us as soon as possible with a copy of all references mentioned in the application, if any, and of any additional prior art of which you are or may become aware, especially any prior art cited in a corresponding foreign application.

COHEN, PONTANI, LIEBERMAN & PAVANE

Markku Simmelvuori, Esq.

August 23, 2001

Page 2

As always we thank you for entrusting this case to us.

With best regards.

Very truly yours,

COHEN, PONTANI, LIEBERMAN & PAVANE

A handwritten signature in cursive script, appearing to read "Lance J. Lieberman".

Lance J. Lieberman

LJL/LAK
Enclosures



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/931,338	08/16/2001	Harri Vatanen	2132-52PCON

CONFIRMATION NO. 2637

FORMALITIES LETTER



OC000000006591505

COHEN, PONTANI, LIEBERMAN & PAVANE
Suite 1210
551 Fifth Avenue
New York, NY 10176

[Handwritten signature]
21 Nov 01

Date Mailed: 09/21/2001



NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 130.

*A copy of this notice **MUST** be returned with the reply.*

[Handwritten signature]

Customer Service Center

Initial Patent Examination Division (703) 308-1202

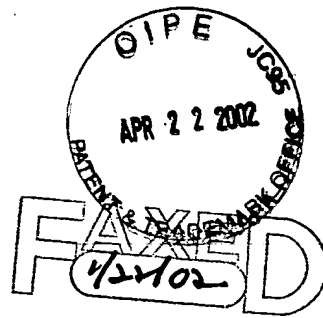
PART 1 - ATTORNEY/APPLICANT COPY

RECEIVED

APR 24 2002

OFFICE OF PETITIONS

P04863080



**COHEN, PONTANI,
LIEBERMAN & PAVANE**

551 Fifth Avenue (Suite 1210)
New York, New York 10176
Tel: 212-687-2770
Fax: 212-972-5487

Fax

REMINDER

*November 2001
21 January 2002
15 February 2002
11 March 2002*

To: Markku Simmelvuori

From: Lance J. Lieberman

Fax: 011 358 9 3480 0630

Pages: 1 (total number of pages)

Re: 14916S --- 2132-52PCON

Date: Thursday, October 04, 2001

☐ Confirmation will follow

☒ No confirmation to follow

We have now received and enclose herewith a copy of the Notice to File Missing Parts received from the U.S. Patent and Trademark Office. We now have until 21 November 2001 by which to file the executed Declaration and Power of Attorney sent to you on 8 September 2001 without paying the government fees for extensions of time. Thereafter, the filing schedule is as follows:

✓ One month extension	-	21 December 2001
✓ Two month extension	-	21 January 2002
✓ Three month extension	-	21 February 2002
✓ Four month extension	-	21 March 2002
Five month extension	-	21 April 2002

RECEIVED

APR 24 2002

OFFICE OF PETITIONS

We look forward to the receipt of the executed Declaration -- as well as the Assignment document -- at your earliest convenience.

Confidentiality Statement

This transmission may contain information which is legally privileged or otherwise protected from disclosure. Its contents are confidential and intended for the addressee only, and must not be used, copied or disseminated by any person other than the addressee. The recipient is requested to notify the sender immediately of any error in transmission and to destroy any transmission not intended for the recipient.

If all pages are not received
or you otherwise experience transmission difficulties
Please call us at (212) 687-2770

FAXED

10/04/01
[Signature]



SmartTrust Ltd, P.O. Box 426 FIN-00051 SONERA, Elimeenkatu 17-19 Helsinki Finland
T +358 (0) 2040 63031 F +358 (0) 2040 62730 E info@smarttrust.com I www.smarttrust.com



DECLARATION

11.4.2002

REGARDING EFFORTS TO HAVE THE DECLARATION AND POWER OF ATTORNEY SIGNED FOR US PATENT APPLICATION 09/931,338, OUR REF 1060US

I work as Patent Manager for Smarttrust Systems Oy and Sonera Smarttrust Oy
Papula Oy is our patent attorney for this case

Papula Oy has sent us a declaration and power of attorney (hereafter called "the document") in this case to be undersigned by the inventor.

The inventor, Harri Varanen, has left the company and refuses to undersign the document.

I have made several attempts to get his signature both orally and in writing.

The documents were sent to him at least three times. I did not take a copy of every letter regarding this matter I sent to him. I have copies left of the letters sent to him on August 22, 2001 and November 30, 2002. Additionally, I remember for sure that I sent a bundle of documents for each US application we need his signature to. We received no answers to these letters even if we reminded him also by telephone.

I did not write down the exact date for each telephone conversation with him but I can assure that there were at least three of them. I also met him once (sometimes between September and December 2001) and asked for the signatures

In the telephone conversations and in the meeting he said that he will sign the declaration and power of attorney but not the assignments. The documents and assignment were sent to the address he gave us but still he never signed even if we sent the documents to him and reminded him over and over again.

The inventor lives in the United Kingdom

I have thus done everything what is reasonably possible to get the signature.

Paivi Soderman

Patent Manager
Smarttrust Systems Oy

RECEIVED

APR 24 2002

OFFICE OF PETITIONS



SmartTrust Ltd, P.O. Box 425, FIN-00051 SONERA, Etelänselkä 17-19, Helsinki, Finland
T +358 (0) 2040 83031 F +358 (0) 2040 82730 E info@smarttrust.com | www.smarttrust.com

①

Covering Letter

TO Harri Vatanen
SUBJECT Allekirjoitettavia dokumentteja
FROM Paivi Soderman
DATE August 22, 2001

☐ URGENT ☐ AS AGREED FOR YOUR ACTIONS ☒ TO BE RETURNED
☐ FOR YOUR INFORMATION ☐ FOR YOUR RECORDS ☒ TO BE SIGNED ☐ RETURNING TO YOU

Reference: 1118

Hei Harri!

Onessa lähetän sinulle allekirjoitettavaksi asiakirjoja. Palauttaisitko ne minulle osoitteeseen.

Sonera SmartTrust Oy
Paivi Soderman
PL 425 FIN-00051 SONERA
FINLAND

Kiitos!

Terveisin

Paivi Soderman
Patent Manager
SmartTrust

Tel +358 40 556 9190

①

Reference: 1118

Hello Harri!

Enclosed I am sending you documents for signing. Please return them to me to the address:

Sonera SmartTrust Oy
Päivi Söderman
P.O. Box 425, FIN-00051 SONERA
FINLAND

Thank you!

Best regards,

Päivi Söderman
Patent Manager
SmartTrust

Tel. +358 40 556 9190

(2)

**Covering Letter**

TO Harri Vatanen
SUBJECT Patenttiasiakirjoja allekirjoitettavaksi
FROM Johanna Heikkinen/Smarttrust
DATE November 30, 2001

☐ URGENT ☐ AS AGREED ☐ FOR YOUR ACTIONS ☒ TO BE RETURNED
☐ FOR YOUR INFORMATION ☐ FOR YOUR RECORDS ☒ TO BE SIGNED ☐ RETURNING TO YOU

Reference: 1118

Hei Harri!

Ohessa lahetan sinulle uudelleen patenttiasiakirjoja allekirjoitettavaksi.
Palauttaisitko ne ystävällisesti osoitteeseen

Sonera Smarttrust Oy
Paivi Soderman
P.O. Box 425, FIN-00051 SONERA
FINLAND

Jos sinulla on jotain kysyttävää, niin voit soittaa Paivi Sodermanille numeroon
040 556 9190

Terveisin,

Johanna Heikkinen

Johanna Heikkinen
Development Assistant
Sonera Smarttrust Ltd

T +358 2040 62345
M +358 40 539 1709
F +358 2040 65117
E johanna.heikkinen@smarttrust.com

LIITTEET 1 siirtokirja, 1 valtakirja

2

Reference: 1118

Hello Harri!

Enclosed I am re-sending you patent documents for signing. Please return them to the address:

Sonera SmartTrust Oy
Päivi Söderman
P.O. Box 425, FIN-00051 SONERA
FINLAND

If you have any questions, please call Päivi Söderman at 040 556 9190.

Best regards,

Johanna Heikkinen

Sonera SmartTrust Oy
Johanna Heikkinen
Development Assistant
Sonera Smarttrust Ltd.

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F +358 2040 65117
E johanna.heikkinen@smarttrust.com

ENCLOSURES : 1 assignment, 1 power of attorney



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V

Covering Letter

TO Hami Vatanen
SUBJECT Allekirjoitettavia asiakirjoja
FROM Paivi Soderman/SmartTrust
DATE September 6, 2001

☒ URGENT ☐ AS AGREED ☐ FOR YOUR ACTIONS X TO BE RETURNED
☐ FOR YOUR INFORMATION ☐ FOR YOUR RECORDS X TO BE SIGNED ☐ RETURNING TO YOU

Reference: puhelinkeskustelu Vatanen/Soderman

Hei Hami!

Viaten puhelinkeskustelumme lahetan sinulle onessa uudestaan dokumentteja
allekirjoitettavaksi.

Palauttaisitko ne minulle osoitteeseen.

Sonera SmartTrust OY

Paivi Soderman

PL 425, FIN-00051 SONERA

FINLAND

Kiitos!

Terveisin,

Paivi Soderman

Patent Manager

SmartTrust

LIITTEET dokumentteja 1060, 1118, 1051, 1055

V

Hello Harri!

Referring to our telephone conversation I am re-sending you documents for signing.

Please return them to me to the address:
Sonera SmartTrust Oy
Paivi Söderman
P O Box 425, FIN-00051 SONERA
FINLAND

Thank you!

Best regards.

Paivi Söderman
Patent Manager
SmartTrust

ENCLOSURES: documents 1060, 1118, 1051, 1055

DECLARATION

The undersigned, translator, Master of Arts, graduated from the University of Jyväskylä,

HEREBY solemnly declares that the appended translation in English is a true and faithful translation of letters sent to Mr. Vatanen.

AND I make this solemn declaration sincerely believing it to be true.

Tiina Hemming-Sorejeff

Translator's name and address:

Tiina Hemming-Sorejeff
PAPULA OY
Fredrikinkatu 61 A
FIN-00100 HELSINKI
Finland